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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,889	05/29/2001	Joseph J. Ervin	P5817	5576

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EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 04/20/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/866,889

Applicant(s)

ERVIN, JOSEPH J.

Examiner

Khanh Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-38 is/are allowed.
- 6) ☒ Claim(s) 1-22, 26 and 39 is/are rejected.
- 7) ☒ Claim(s) 23-25, 27, and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 1-9, 10-19, and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9 are directed to an apparatus. However, the essential structural cooperative relationship(s) between elements in the claims such as "port A interface," "port B interface," and "controller" have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

Claims 10-19, and 39 are directed to an apparatus. However, the essential structural cooperative relationship(s) between elements in the claims such as the first bridge, second bridge, first and second ports A, and first and second ports B, have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7, 20-22, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Schutte.

At the outset, it is noted that similar will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any structure that differs from Schutte. With regard to claim 1, Schutte disclose a bridge apparatus for connecting a first multimaster bus I2C (12a) environment to a second multimaster bus I2C (12b) environment, comprising an address bitmap (address of stations 10 defined for the I2C bus) having a value associated with each possible I2C address; a port-A interface (conductors/interface on the upstream of bridge 14) that receives address signals and data signals from the first multimaster and transmits data signals to the first multimaster bus (12a); a port-B interface (conductors/interface on the downstream of bridge 14) that transmits address signals and data signals to the second multimaster bus (12b) and received data signals from the second multimaster bus; and a controller (bridge 14) that selectively passes an address and data received on the port-A interface from the first multimaster bus to the port-B interface for transmission on the second multimaster bus depending on the address bitmap value associated with the address.

With regard to claim 2, the controller (14) comprises a command interpreter (including at least CRT, BT and 148) that receives commands at the port-A interface (conductors/interface upstream of 14) from the first multimaster bus (12a) and controls the operation of the bridge apparatus in response to received commands.

With regard to claim 3, a tunnel command received by the bridge apparatus includes a tunnel address (station address) and the controller (14) passes the tunnel address to the port-B interface (conductors/interface downstream of 14) for transmission on the second multimaster bus (12b). See also Fig. 1 and description thereof.

With regard to claim 7, it is clear that the controller (14) is a programmed Microcontroller so that it can recognize the ID address of the stations.

With regard to claims 20-22, and 26, it is clear that one using the device of Schutte would have performed the same steps set forth in claims 20-22, and 26.

### ***Response to Arguments***

Applicants' arguments filed 2/09/2004 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is

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the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

**The 122 Rejection:**

MPEP 2172.01 clearly states that “a claim which fails to interrelate (emphasis added) essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). It is clear that various recited elements function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes. The amended language to claims 1 and 10 do not provide any structural relationships between recited elements in the claims. It is suggested that the word “connected” may be used to provide structural relationships between elements.

**The Schutte 102(e) Rejection:**

With regard to claims 1 and 20, Applicant argued that Schutte does not disclose "buffers the received address signals and data signals. Schutte discloses no elements in its bridge circuit that buffers address and data signal." Contrary to Applicant's argument, it is not a matter of possibilities or probabilities, it is a matter of fact that the address and data signal are transmitted from the first multimaster bus (12a) to the bridge including upstream and downstream interfaces and conductors, and the data signals temporarily stay in the bridge (note that the bridge is placed between the first multimaster bus (12a) and second multimaster bus (12b)). In another word, it is clear that in Schutte, port A interface "buffers" the received address and data signal. Applicant also argued that "[t]he Schutte bus does not retransmit signals." Contrary to Applicant's argument, in Schutte, signals are transmitted bi-directionally between the first multimaster bus 12(a) and second multimaster bus 12(b) via bridge 14 disposed between the first bus and second bus. In another word, signals have temporarily been stored in the bridge before they are transmitted again (retransmitted) to predetermined destinations.

**The 103 Ervin et al. Rejection:**

Applicant argued that is invalid because "[t]he Ervin reference issued after the filing date of the present application and is therefore a reference solely under 35 U.S.C. 102(e). The invention of this application 09/866,899 and the subject matter of U.S. Patent No. 6,591,322 B1 were, at the time the invention of this application 09/866,899 was made, owned by Sun Microsystems, Inc. consequently, the subject matter of U.S.

Patent No 6,591,322 B1 cannot preclude patentability under 35 U.S.C. 103(a) by virtue of 35 U.S.C. 103(c)."

Upon further review, the Examiner agrees with Applicant that U.S. Patent No. 6,591,322 and Application No. 09/866,899 are both owned by Sun Microsystems, Inc. and therefore, the subject matter of U.S. Patent No 6,591,322 B1 shall not preclude patentability under 35 U.S.C. 103(a) by virtue of 35 U.S.C. 103(c).

***Allowable Subject Matter***

Claims 29-38 are allowed.

Claims 4-6, 8-19, and 39 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 23-25, 27, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

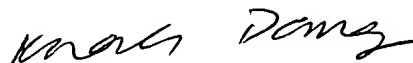
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.

A handwritten signature in black ink, appearing to read "Khanh Dang", written in a cursive style.

**Khanh Dang**  
**Primary Examiner**